

### **REMARKS**

This Amendment, together with a Request for Continued Examination, is submitted in response to the final Office Action mailed December 3, 2010. In view of the above claim amendments, the following remarks and the enclosed Declaration of Dr. David Lucantoni, reconsideration by the Examiner and allowance of this application is respectfully requested.

Applicant thanks Examiner Jamie Kucab for the courtesy and suggestions offered during the telephonic Examiner Interview on February 1, 2011. During the Interview, the Examiner discussed priority issues and the pending rejection under 35 USC §101. It was agreed Applicant would amend the claims such that the periodic transfer of funds step is performed by a computer.

Accordingly, Claims 75, 78, 85 and 99 are amended to more particularly point out and distinctly claim the subject matter that applicant regards as the invention. In particular, Claim 75 is amended to state that the periodic and automatic money transfers occur under computer processor control. This is disclosed in the specification at page 19, lines 10 – 15 and does not introduce new matter. Claims 78 and 85 are amended as recommended by the Examiner in the Office Action to overcome rejections for indefiniteness. This also does not introduce new matter. Finally, Claim 99 is amended to require that information on how the allowance money is spent is provided to the fund depositor through a computer network. This is disclosed in the specification from page 12, line 28 to page 13, line 2 and also does not introduce new matter.

. For the reasons submitted below, the claims are in condition for allowance. Reconsideration by the Examiner and allowance of the pending claims is therefore respectfully requested.

Turning to the Office Action, the Examiner acknowledged but did not grant Applicant's claim for benefit of prior-filed US Patent Application Serial No. 08/585,173 ("the '173 application"), filed April 16, 1996. The Examiner stated that the '173 application "fails to provide the necessary support for such limitations as 'computer-based' of ... independent claims 75 and 99 and 'encoding a debit card linked to said third party account with third party account information permitting cash withdrawals or fund transfers as payments for goods or services' of independent claim 99." In view

of the above claim amendments and the enclosed Declaration of Dr. Lucantoni, Applicant respectfully disagrees.

Applicant contends that the '173 application provides sufficient information and direction to have allowed one of ordinary skill in the art at the time of the invention to have understood that a computer-based implementation of the inventive allowance card and support system as presently claimed was intended. Claim 75 now requires that the transfer of allowance money occur periodically and automatically under computer processor control. Claim 99 now requires that the fund depositor be supplied through a computer network information on payees and corresponding payment amounts for the third party account.

The '173 application discloses the implementation of the allowance card invention disclosed therein through a credit card network in which money is transferred to a child every month and the parent receives information on how the money is spent. In particular, the '173 application states:

The philosophy of the Allowance Card and how it works is very simple. A major credit card company [such as] Visa, Master Card, Discovery [(sic.)]. AmEx, will be the support. Say John Doe has a card such as those stated above. He has a son and a daughter in high school and wants to give them a monthly allowance but is afraid just handing out money and where they are spending it. He has the card company issue two allowance cards under his main account. He tells the card company to take \$80 dollars a month, charge it to his account, and put \$40 to each of his children's allowance cards. They can only spend that \$40, no more[. If they choose to spend it quicker or slower within the month it is their choice[. T]he parent is disciplined not to give them anymore money until the next month and the kids are disciplined by the Allowance Card constraints.

The disclosure also states that the allowance card allows quick and direct money transfers and documents the day, place, amount and items that were purchased. While the presently claimed invention may have started out as an idea conceived by the inventor to issue spending cards to children on which a periodic allowance could be loaded, by the time the '173 application was filed, the inventor had come to realize that the computer network of a credit card company could be used to make the periodic and automatic transfer of money to "siblings, children and others who are dependent on wage earners ... college students, handicapped people ... [emphasis omitted]."

This demonstrates that at least as of the April 16, 1996 filing date of the '173 application, the inventor was in possession of transferring allowance money periodically and automatically under computer processor control, to which Claim 75 is directed, and supplying fund depositors through a computer network information on payees and corresponding payment amounts for the third party account, to which Claim 99 is directed.

Applicant provides herewith the Declaration of Dr. David Lucantoni, which elaborates in additional detail how the computer-based context in which Applicant's invention would have been understood to have operated. In particular, as noted in the Declaration, then-existing credit card and banking computer networks were capable of implementing the allowance card and its system, hereinafter collectively referred to as "the allowance card system," as defined by the presently amended claims.

According to Dr. Lucantoni, a person of ordinary knowledge and skill in matters involving credit and debit cards, upon being informed of the allowance card concept related by the '173 application, and informed by the '173 application that it would be supported by a major credit card company, would have understood this to encompass transferring allowance money periodically and automatically under computer processor control, to which Claim 75 is directed, and supplying fund depositors through a computer network information on payees and corresponding payment amounts for the third party account, to which Claim 99 is directed, not to mention the other features recited in the claims. To the extent this is not expressly described, it would be inherently or implicitly conveyed to them. Furthermore, existing credit card and banking networks were capable at that time of implementing the invention as it is now claimed.

Also, as noted by Dr. Lucantoni, there are several features of the allowance card system for which a computer network is required for any reasonably practical application. For example, linking the allowance card to a third-party account for quick and direct money transfers and documenting the day, place, amount and items that were purchased, as well as enforcing transaction limits – where information from more than one merchant might be needed in a short time span – are simply not practical unless a computer system and database are used.

Dr. Lucantoni explains that one of ordinary skill in the art at the time the '173 application was filed would have recognized that the invention described in the '173 application encompassed writing one or more computer routines that were within their ability to implement, to modify existing bank and credit card computer networks to perform the various functions as described in the '173 application. These computer routines could then be integrated into an existing credit/banking network, thereby enabling it to perform the described functions. A person of ordinary skill in the art reading the '173 application would have recognized that an allowance card system based on existing bank and credit card computer networks at the time of the '173 application could be implemented using only existing magnetic card technology, electronic card readers, communication lines, and computers programmed to process transactions and update the information stored one or more database, and using only the description provided in the '173 application.

Dr. Lucantoni concludes that the '173 application contains all the direction, either by express explanation or inherent or implicit teaching, that is needed to practice the invention as it is now recited in the claims.

To be entitled to an earlier priority date or filing date under 35 U.S.C. §§119, 120 or 365(c), each claim limitation must be expressly, implicitly or inherently supported in the originally filed disclosure (*See* MPEP §2163). In other words, there must be compliance with the written description requirement of 35 U.S.C. §112, first paragraph vis-à-vis the pending claims and the application to which priority is asserted. Based on the '173 Application as filed and the general knowledge in the art, those of ordinary skill in the art would recognize that Applicant was in possession of the entire scope of the invention as now recited in Claims 75 and 99.

It is well established that compliance with the written description requirement is essentially a fact-based inquiry that will “necessarily vary depending on the nature of the invention claimed.” *Ariad Pharmaceuticals Inc. v. Eli Lilly & Co.*, Fed. Cir., No. 2008-1248 at 24 (April 3, 2009) quoting *Capon v. Eshhar*, 418 F.3d 1349, 1357-58, (Fed. Cir. 2005); also *Enzo Biochem Inc. v. Gen Probe Inc.*, 323 F.3d 956 (Fed. Cir. 2002) quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991); *In re Ruschig*, 54 CCPA 1551 (CCPA 1967). In fact, “to satisfy the written description requirement, applicant does not have to utilize any particular form of disclosure.”

*Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.* 541 F.3d. 1115, 1122 (Fed. Cir. 2008). “[W]hat is conventional or well known to one of ordinary skill in the art need not be disclosed in detail.” *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed Cir. 1986).

Accordingly, when reviewing the disclosure for compliance with the written description requirement, the disclosure must be assessed objectively for a showing as to whether it conveys to one of ordinary skill in the art that the inventor had possession of the claimed subject matter at the time the application was filed. *See* The USPTO Written Description Training Materials, Revision 1, March 25, 2008 (the “Written Description Guidelines”) at p. 4.

The written description requirement does not require a specification to recite the claimed invention *in haec verba*. *Ariad Pharmaceuticals Inc. v. Eli Lilly & Co.*, at 1352. Moreover, the Written Description Guidelines do not require an *ipsis verbis* disclosure of all species of the claimed invention.

The express teaching of the ‘173 application that a credit card network be utilized to implement the invention expressly, implicitly and inherently supports the invention as it is presently claimed. Accordingly, reconsideration by the Examiner and acknowledgment that Applicant is entitled to receive the benefit of the filing date of the ‘173 Application is respectfully requested.

Next, the Examiner objected to claim 85 for informalities and suggested that “wherein said money is transferred” should have been recited. Claim 85 has been amended as suggested by the Examiner. Accordingly, reconsideration by the Examiner and withdrawal of this objection is respectfully requested.

Next, the Examiner rejected claims 75, 78 – 83, 85, 87, 99 and 114 under 35 U.S.C. §101 as directed to non-statutory subject matter for being directed to an abstract idea. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

As discussed during the Examiner Interview, Applicant herein amends independent claim 75 to recite that the transfer of allowance money occurs periodically and automatically under computer processor control. Claim 99 now has been similarly amended to require that the fund depositor be supplied through a computer network information on payees and corresponding payment amounts for

the third party account. As discussed at the interview at least with respect to Claim 75, these limitations are not abstract and represent tangible transformations performed by computers.

By amending Claims 75 and 99 in this manner, this rejection of claims 75, 78 – 83, 85, 87, 99 and 114 under 35 U.S.C. §101 as directed to non-statutory subject matter has this been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Also in the Office Action, the Examiner rejected claims 75, 78 – 83, 85, 87 and 114 under 35 U.S.C. §112, second paragraph, as indefinite, stating that “said information on payees” in claim 75 is unclear as to what information is referred to, and that “said fund depositor account” lacks an antecedent basis. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

Applicant herein amends claim 75 to conform to language recommended by the Examiner to clarify that the information referred to is not the prior-recited “information from a fund depositor.” Applicant also amends claim 75 to conform to language suggested by the Examiner to provide an antecedent basis for the “fund depositor account.” By amending Claim 75 as recommended by the Examiner, this rejection of claims 75, 78 – 83, 85, 87 and 114 under 35 U.S.C. §112, second paragraph, as indefinite has this been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Also in the Office Action, the Examiner rejected claims 75, 77, 99 and 101 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,953,710 to *Fleming*. Applicant respectfully traverses this rejection.

Applicant notes *Fleming* was filed October 9, 1996, whereas Applicant claims priority from the ‘173 Application, which was filed April 16, 1996, and is entitled to this priority date for the reasons set forth above. Because the present application has a priority date earlier than *Fleming*’s filing date, *Fleming* is not prior art against the present application, *i.e.*, *Fleming* is not available as a 35 U.S.C. §102(e) reference for rejecting the present application. Thus, the rejection of claims 75, 77, 99 and 101 as anticipated by *Fleming* under 35 U.S.C. §102(e) should be withdrawn.

Reconsideration by the Examiner and withdrawal of this rejection is respectfully requested.

Next, the Examiner rejected claims 78 – 83, 85, 87, 102 – 107, 110 and 114 under 35 U.S.C. §103(a) as obvious over *Fleming* in view of U.S. Patent No. 5,500,513 to *Langhans, et al.* Although admitting that *Fleming* fails to teach “the steps of: (a) limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer; (b) verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased; (c) wherein said goods or services comprise books, computer software, food, lodging or entertainment; (d) wherein said limit is a periodic limit; and (e) wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco,” the Examiner states that *Langhans, et al.* provides these steps. The Examiner further states that it would have been obvious to modify *Fleming* to include the teachings provided by *Lanhhans, et al.* This rejection is respectfully traversed for the reasons set forth hereinafter.

Applicant first notes that claims 78 – 83, 85, 87, 102 – 107, 110 and 114 depend directly or indirectly from Claim 75 or Claim 99 and are directed to allowable subject matter for the same reasons that these claims are allowable. *I.e., Fleming* is no longer available as a reference because of Applicant’s priority claim to the ‘173 application, as explained above. Therefore, any rejections based on *Fleming* in combination with another reference should be withdrawn. Applicant also notes that *Langhans, et al.*, being drawn to a *corporate* “purchasing control system,” does not provide the type of system needed for a *personal* application, such as in *Fleming*, and thus does not make up for the withdrawal of *Fleming* as obviating prior art.

For the foregoing reasons, this rejection of claims 78- 83, 85, 87, 102-107, 110 and 114 under 35 U.S.C. §103(a) as obvious over *Fleming* in view of *Langhans, et al.* has thus been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefor respectfully requested.

Finally, the Examiner rejected claims 75, 78 – 83, 85, 87, 99 and 114 on the grounds of non-statutory obviousness-type double patenting over claims 1-10 of U.S. Patent No. 7,653,595 and noted that the rejection could be overcome with the timely filing of an appropriate terminal disclaimer. Accordingly, a terminal disclaimer is filed herewith to overcome this rejection. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

In view of the claim amendments, foregoing remarks and Declaration of Dr. David Lucantoni filed herewith, this application is now in condition for allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned at the below listed telephone number should there be any issues remaining to be resolved.

If there are any additional charges in connection with this response, the Examiner is authorized to charge Applicant's Deposit Account No. 50-1943 therefore.

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Respectfully submitted,

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